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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,171	11/09/1999	JOHN M. KRAJNIK	5661	7614

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EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 04/02/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/437,171

Applicant(s)

KRAJNIK ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. *A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.*

Applicant's submission filed on 13 January 2003 has been entered.

Claim Rejections - 35 USC § 112

2. *The following is a quotation of the second paragraph of 35 U.S.C. 112:*

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. *Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

The recited "further comprising a second polymer comprising the reaction product of (i) – (iv)" per the claim supra constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited component 8(b), i.e., not clear if it is the same as or in addition to component 8 (b).

Claim Rejections - 35 USC § 112

4. *The following is a quotation of the first paragraph of 35 U.S.C. 112:*

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. *Claims 1-17 and 27-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As far as the Examiner can tell, no express support can*

Art Unit: 1713

be found for the recited limitation "wherein the amount of the monoethylenically unsaturated monomer containing latent crosslinking functionality is in a range that extends from greater than 5 weight percent to 50 weight percent" per claims 1 and 8 and, as such, without any express guidelines from applicants as to where support might be found, this engenders a New Matter situation.

Claim Rejections - 35 USC § 103

6. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. *The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:*

- 1. Determining the scope and contents of the prior art.*
- 2. Ascertaining the differences between the prior art and the claims at issue.*
- 3. Resolving the level of ordinary skill in the pertinent art.*
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.*

8. *This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

Art Unit: 1713

9. *Claims 1, 2, 4-7, 15, 16 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cruden et al(U.S. 4,176,103) in combination with Huth et al(U.S. 5,102,936).*

Cruden et al disclose and exemplify aqueous dispersions of carbonyl-group containing polymers (polymer latexes), useful in coating and binder compositions such as paints, adhesives, paper coatings, etc., wherein said polymer is derived from carbonyl-containing monomers such as vinyl acetoacetate, diacetone acrylamide, etc. and other monoethylenically unsaturated monomers which include fatty acid vinyl esters, esters of (meth)acrylic acid such as butyl acrylate, unsaturated carboxylic acids which include (meth)acrylic acid, etc. Cruden et al @ col. 6, lines 1-7, further invite the use of conventional materials such as thickeners, dispersing agents and other commonly known additives in formulating the antecedently recited aqueous polymer dispersions. More specifically, Cruden et al exemplify diacetone acrylamide-governed polymer latexes derived from 44 wt.% of methyl methacrylate, 50 wt.% of butyl acrylate, 2 wt.% of methacrylic acid and 4 wt.% of diacetone acrylamide and clearly overlapping in scope with component (a) per claim 1. See, e.g., the Abstract, cols. 1-6 and the Runs, especially Run 2 of Cruden et al.

Huth et al teach aqueous surface-active, urethane derivatives-govern copolymer-containing aqueous dispersions, useful in enhancing the rheological and thickening properties in aqueous preparations such as non-spatter emulsion paints, wherein said copolymers are derived from ethylenically unsaturated monomers which comprise a) 25 to 85 wt.% of ethylenically unsaturated hydrophobic monomers, b) 1 to 50 wt.% of ethylenically unsaturated monomers capable of salt formation, c) 0.1 to 30 wt.% of macromonomer units of surface-active urethane derivatives, d) 0 to 10 wt.% of other ethylenically unsaturated monomers containing functional radicals which include n-

methylo(meth)acrylamide, e) 0-5 wt.% of carbonyl-group containing compounds, etc., said copolymer comfortably overlapping in scope with component (b) per claim 1. See, e.g., the Abstract, cols. 2-10 and the Runs of Huth et al.

The disclosure of Cruden et al differs basically from the claimed invention as per the non-express disclosure of an embodiment directed to the precisely defined second polymer (b) per the claimed invention. However, Cruden et al at col. 6, lines 1-6 teaches that the coating compositions derived from these modified polymer latexes can include materials such as thickeners, dispersing agents, etc. To this end, one having ordinary skill in the art would have found it obvious, on its face, to use the copolymer of Huth et al, as the thickener and/or dispersant in the aqueous system of Cruden et al and with a reasonable expectation of obtaining the cumulative additive effect, i.e., a reasonable expectation of success. Criticality for such, clearly commensurate in scope with the claims, not having been demonstrated on this record. Further, the interchangeability of one well known latent crosslinking agent for another is a matter of ordinary choice to the skilled artisan and with a reasonable expectation of success, absent some unusual or unexpected results(see, e.g., claim 7).

As to the latent crosslinking monomer per claim 2 as dependent from claim 1 and governed by a content in excess of 5 wt. %, such would have been prima facie obvious, based on the close proximity between the lower content of the latent crosslinking monomer per the claimed invention and the upper limit content of 5 wt.% described per Huth et al, with the resulting expectation that the copolymers would have the same or substantially the same properties(Titanium Metals Corp. v. Banner, 778 F2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985).

Allowable Subject Matter

Art Unit: 1713

10. *Claims 3, 8-14, 17 and 28-30 are deemed allowable over the prior art of record. Claims 3, 8-14, 17 and 28-30 would be allowed if rewritten, amended and/or satisfactorily rebutted so as to obviate the 112, 1st and 2nd paragraph issues raised supra.*

Response to Arguments

11. *Applicant's arguments filed 01/13/03 have been fully considered but they are not persuasive.*

Relative to Cruden/Huth---It is urged and maintained that the instantly claimed invention is obvious within the meaning of 35 USC 103 over Cruden et al in combination with Huth et al as per reasons clearly stated in the Grounds of Rejection of record. The crux of Counsel's arguments appear to hinge on the content of latent crosslinking functional monomer per claims 1 and 8, i.e., "greater than 5 weight percent"(claimed invention) vs "up to 5 weight percent" per Huth et al. Counsel is cordially invited to review the teachings of Huth which include as a component (d) "up to 10 weight percent" of at least one monomer which clearly overlaps in scope with the latent crosslinking monomer per component (b) of claims 1 and 8.

Conclusion

12. *The prior art made to Plamondon et al(U.S. 4,107,120) is cited to show that N-alkylol(meth)acrylamides are commonly known as latent crosslinking monomers.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Application/Control Number: 09/437,171

Page 7

Art Unit: 1713

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR JMN
March 28, 2003